

Exhibit S



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

PAUL D. BIANCO
FLEIT GIBBONS GUTMAN
BONGINI & BIANCO PL
21355 EAST DIXIE HIGHWAY
SUITE 115
MIAMI FL 33180

MAILED

JUL 14 2010

OFFICE OF PETITIONS

In re Application of
Bonutti

Application No. 10/003,996

Filed: 15 November, 2001

Attorney Docket No. 780-A02-014-8

DECISION ON PETITION

This is a decision on the petition filed on 18 June, 2010, requesting pursuant to 37 C.F.R. §1.182 that the acceptance of the terminal disclaimer filed 31 March, 2003, be withdrawn

NOTE:

Buried, submarined, in one paragraph among approximately 114 pages of Petitioner's papers¹—is the suggestion that Petitioner not only expressly requests withdrawal of a terminal disclaimer pursuant to 37 C.F.R. §1.182, but also seeks outside of the appropriate rule a patent term extension.

Such a practice is inappropriate.²

Petitioner may plead appropriately as to withdrawal of the terminal disclaimer, and Petitioner may plead appropriately for relief as to term extension.

And Petitioner shall be express from the outset as to his intents.

The petition pursuant to 37 C.F.R. §1.182 is DISMISSED.

¹ Petition, page 6.

² See: 37 C.F.R. §1.4(e).

It is noted that, as of this writing, the Examiner(s) in charge of this application has not concurred with the request.

The guidance in the Commentary at MPP §1490 provides in pertinent part:

VII. WITHDRAWING A RECORDED TERMINAL DISCLAIMER

If timely requested, a recorded terminal disclaimer may be withdrawn before the application in which it is filed issues as a patent, or in a reexamination proceeding, before the reexamination certificate issues. After a patent or reexamination certificate issues, it is unlikely that a recorded terminal disclaimer will be nullified.

A. Before Issuance Of Patent

While the filing and recordation of an unnecessary terminal disclaimer has been characterized as an "unhappy circumstance" in *In re Jentoft*, 392 F.2d 633, 157 USPQ 363 (CCPA 1968), there is no statutory prohibition against nullifying or otherwise canceling the effect of a recorded terminal disclaimer which was erroneously filed before the patent issues. ³Because the terminal disclaimer would not take effect until the patent is granted, and the public has not had the opportunity to rely on the terminal disclaimer, relief from this unhappy circumstance may be available by way of petition or by refiling the application (other than by refiling it as a CPA).

Under appropriate circumstances, consistent with the orderly administration of the examination process, the nullification of a recorded terminal disclaimer may be addressed by filing a petition under 37 CFR §1.182 requesting withdrawal of the recorded terminal disclaimer. Petitions seeking to reopen the question of the propriety of the double patenting rejection that prompted the filing of the terminal disclaimer have not been favorably considered. The filing of a continuing application other than a CPA, while abandoning the application in which the terminal disclaimer has been filed, will typically nullify the effect of a terminal disclaimer. The filing of a Request for Continued Examination (RCE) of an application under 37 CFR §1.114 will not nullify the effect of a terminal disclaimer. ³because a new application has not been filed, but rather prosecution has been continued in the existing application. (Emphasis supplied.)

Moreover, Petitioner's discussion makes clear that Petitioner expressly determined as to prosecution strategy to submit the terminal disclaimer notwithstanding Petitioner's own beliefs that the disclaimer was unnecessary.³

At this writing, the history of conflict as to Petitioner's representations/intentions herein and the Examiner's lack of concurrence make the withdrawal of the 31 March, 2003, TD inappropriate.

³ Petition, page 4, third paragraph.

Accordingly, the petition is dismissed.

This application is released to the Technology Center/AU 3733 for further processing in due course.

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2⁴) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's/Caller's action(s).

/ John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

⁴ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.